

REMARKS

This Amendment ("Amendment") is in response to the November 4, 2004 Office Action ("Office Action"). Claims 1-33 and 68-74 are pending; claims 34-38 and 66-67, drawn to a kit, were previously withdrawn from consideration, as non-elected group II; claims 39-65, directed to methods of measuring enzymatic activity, were previously withdrawn from consideration, as non-elected group III. Applicant notes that claims 75-78 are dependent claims on withdrawn claims 41 or 45, and are also directed to methods of measuring enzymatic activity. Claims 75-78 are believed to be included in Group III, not Group I as stated in the September 14, 2004 restriction requirement. Applicant reserves the right to prosecute claims 75-78 in the future, but withdraws these claims as being directed to non-elected subject matter.

SUPPORT

Amendments to the Specification

The paragraph of the specification at page 7, line 24 through page 8, line 4 was amended to correct a typographical error. The typographical error was made in the formula of structure II at page 7, line 25. Formula II was amended to include "()_n" in the carbon ring. Support for this change is found in the original specification, for example at page 8, lines 3-4. No new matter is added.

Amendments to the Claims

Claims 1-33 and 68-74 remain in this application. Claims 3, 14, 18, 33, 70, 72, and 74 are amended. Support for the amendment to the claims is found throughout the specification and drawings, for example: (i) at page 19, lines 13-16 for claims 3, 14, 18, 70, 72, and 74; and (ii) at page 17, lines 7-9 for claim 33.

CLAIM REJECTIONS

Claims 1-33, and 68-78 stand rejected under 35 U.S.C. § 112, first and second paragraphs, as allegedly being nonenabled, and indefinite, respectively. Applicants

respectfully assert that all of the claims comply with 35 U.S.C. § 112, first and second paragraphs, and all of the claims are allowable.

The Claims are Enabled

Claims 1-33, 68-78 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. The Office Action states that “the claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.” The Office Action further states with respect to formula XII, that “as claimed, R¹¹, R¹⁴, or R¹⁵ can be anything except not all can be acetyl groups. Such compounds would not function as described.”

Applicants respectfully disagree. The subject matter claimed in this application includes, but is not limited to, formula XII “wherein R¹¹, R¹⁴, and R¹⁵ are independently enzyme-removable groups; with the proviso that R¹¹, R¹⁴, and R¹⁵ are not all acetyl groups,” as stated in claim 1. As such, R¹¹, R¹⁴, and R¹⁵ are enzyme-removable groups.

One skilled in the art would understand the scope of enzyme-removable groups from the disclosure provided in this application. Examples of “enzyme-removable group” include: (i) page 5, line 15, where non-limiting examples of enzyme-removable groups are given, such as “an ester or an ether comprising an enzyme-removable group”; (ii) page 15, lines 23 to page 16, line 12, where applicants state that the enzyme-removable group is a protecting group, examples of which include but are not limited to esters, phosphoryls, glycosyls, fatty acids, *tert*-butyl, and amino acids; and (iii) page 16, lines 2-5, where applicants refer to use of the term “enzyme-removable” in the literature, including US Patent 5,831,102; Tsien, R. Y. *Nature*, 290: 527-28, 1981; Redden, P. R. *et al.*, *Int J Pharm*, 180: 151-60, 1999; and Annaert, P. *et al.*, *Pharmaceut Res*, 14: 492-96, 1997. Detailed examples of how to make embodiments of the claimed invention, which in no way limit the subject matter claimed, are described in Examples 1-8. Example 9 provides an example of how to

use certain embodiments of the claimed invention. While these examples are non-limiting, they are provided to demonstrate aspects of the invention.

The specification as a whole enables one skilled in the art to make and use the invention, and complies with 35 U.S.C. § 112, first paragraph. Reconsideration and withdrawal of this rejection are requested.

The Claims are Definite

Claims 1-33, 68-78 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention. Applicants respectfully traverse each basis for this rejection set forth in the Office Action, as follows:

First, the Office Action contends “enzyme-removable groups” in claim 1 is “so indefinite as to be unsearchable.” Applicants respectfully traverse the basis of this rejection. The subject matter embraced by the claim term “enzyme-removable group” is clearly articulated at many places including: (i) page 5, line 15, where non-limiting examples of enzyme-removable groups are given, such as “an ester or an ether comprising an enzyme-removable group”; (ii) page 15, lines 23 to page 16, line 12, where applicants state that the enzyme-removable group is a protecting group, examples of which include but are not limited to esters, phosphoryls, glycosyls, fatty acids, *tert*-butyl, and amino acids; and (iii) page 16, lines 2-5, where applicants refer to use of the term “enzyme-removable” in the literature, including US Patent 5,831,102; Tsien, R. Y. *Nature*, 290: 527-28, 1981; Redden, P. R. *et al.*, *Int J Pharm*, 180: 151-60, 1999; and Annaert, P. *et al.*, *Pharmaceut Res*, 14: 492-96, 1997. Accordingly, claims containing the term “enzyme-removable groups” meet the requirements of 35 U.S.C. § 112, second paragraph.

Second, the Office Action contends that claim 3 fails to further limit claim 1. Applicants respectfully disagree. In claim 1 R¹¹, R¹⁴, and R¹⁵ “are independently enzyme-removable groups,” while in claim 3, -OR¹¹, -OR¹⁴, and -OR¹⁵ are each independently esters. As discussed above, the specification describes and enables many types of enzyme removable groups, including esters, meaning R¹¹, R¹⁴, and R¹⁵ in claim 1 are not limited to ester enzyme removable groups. Therefore, because

"enzyme-removable groups" in claim 1 is broader than ester enzyme-removable groups described in claim 3, applicants submit that claim 3 further limits claim 1 and is properly dependent on claim 1.

Third, the Office Action contends in claim 6 that "F12 appears to be a trademarked name". Applicants are unaware of such trademark status and respectfully request that the basis of the rejection be withdrawn unless and until evidence to the contrary can be provided.

Fourth, the Office Action contends that "claim 33 describes a compound in functional terms where one would not know the metes and bounds of the claim." Applicants respectfully submit that this description of claim 33 is not accurate. The claimed luminophore is plainly stated to be modified coelenterazine compounds described by chemical formulae. Accordingly, claim 33 sets definite boundaries on the protected luminophore described by using both structural and functional limitations that would allow one skilled in the art to understand the scope of the claimed invention. As such, the metes and bounds of claim 33 are defined.

In view of the discussion presented herein above, applicants respectfully assert that the claims meet the requirements of 35 U.S.C. § 112, second paragraph, and request that this section 112 rejection be withdrawn.

CONCLUSION

Applicants believe that currently pending claims are patentable. Applicants respectfully request that the Examiner grant early allowance of this application. The Examiner is invited to contact the undersigned agent for the Applicants via telephone if such communication would expedite this application.

Respectfully submitted,



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